

REMARKS/ARGUMENTS

In the Office Action mailed November 24, 2009 (hereinafter, "Office Action"), claims 1-34 stand rejected under 35 U.S.C. § 103. Claims 1-4, 9-12 and 17-20 have been amended. Claim 35 has been added.

Applicant respectfully responds to the Office Action.

I. Claims 1-3, 9-11, 17-19, 25-27, 31 and 32 Rejected Under 35 U.S.C. § 103(a)

Claims 1-3, 9-11, 17-19, 25-27, 31 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,213,060 to Kemp et al. (hereinafter, "Kemp") in view of U.S. Patent No. 6,032,162 to Burke (hereinafter, "Burke"). Applicant requests reconsideration in view of the above claim amendments and the following remarks.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 2007 U.S. LEXIS 4745, at **4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a claim." In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)). Moreover, the analysis in support of an obviousness rejection "should be made explicit." KSR, 2007 U.S. LEXIS 4745, at **37. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicant respectfully submits that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the subject matter in the claims.

Independent claim 1 has been amended to recite "determining by the client device if a network address is the network address of the peripheral device, wherein determining includes

sending a communication over the network.” Support for this claim subject matter is found on page 11, line 8 through page 12, line 2 of the filed specification. Applicant submits that such claim subject matter is not taught or suggested by the cited references.

The Office Action does not cite to any portion of Burke that would allegedly teach “determining if a network address is the network address of the peripheral device.” (Office Action, page 4). Further, Applicant has not identified any portion of Burke that would allegedly satisfy this claim subject matter. Rather, the Office Action cites to “Figure 6” of Kemp to allegedly teach this claim subject matter. (See id.). However, as noted above, Figure 6 simply shows a webpage containing a hyperlink with the network addresses of the printer for a user to select. (See Kemp, col. 7, lines 9-21). This displayed hyperlink network address in Kemp does not “determin[e] if a network address is the network address of the peripheral device.” In fact, there is no need to “determine” anything in Kemp because the printer’s network address is already displayed to the user. However, in order to further distinguish this claim subject matter from Kemp, claim 1 has been amended to recite that the “determining includes sending a communication over the network.” Figure 6 of Kemp does not show actually sending a communication over the network (such as via “pinging,” sending a test message, etc.) as a way to determine whether the address is correct. For this reason, Kemp fails to teach this claim subject matter.

On page 5 of the Office Action, the Office Action indicates that “the Kemp-Burke combination makes obvious recognizing an address as discussed and testing as claimed in that once the user tries to use the address, the user will be ‘testing’ it.” (Office Action, page 5). Applicant disagrees with this interpretation.

As noted in the claim 1, Applicant’s method involves “determining by the client device if a network address is the network address of the peripheral device, wherein determining includes sending a communication over the network” and that this “determining” occurs before the peripheral device is formally “address[ed]... using the determined network address.” Once addressed, the peripheral device may be “communicat[ed]” with “directly... thereby bypassing the server device.” Thus, claim 1 requires sending a communication over the network as a means of “determining”

whether the network address is correct, and then formally using the network address to communicate with the peripheral device. Amended claim 1 thus requires sending two (2) separate communications to the device via the network. Under the interpretation set forth by the Office Action, there is only one (1) communication with the peripheral device, namely “once the user tries to use the address, the user will be ‘testing’ it.” (Office Action, page 5). “Trying” the peripheral device—e.g., sending the peripheral device a formal print job to “test” it—is not the same as the present claim 1 which requires sending a first communication to determine whether the address is correct and a second communication which formally transmits the print job. Accordingly, for this reason, the interpretation of Kemp-Burke in the Office Action is erroneous and does not render obvious the present amended claim 1. Withdrawal of this rejection is respectfully requested.

Amended claim 1 also recites “creating a print job, wherein the print job is to be sent to the peripheral device” and “determining a network address of the peripheral device by the client device in response to the creation of the print job.” Accordingly, the print job is created before the network address of the peripheral device is determined. In fact, the network address of the peripheral device is determined in response to the creation of the print job. Applicant submits that such claim subject matter is not taught or suggested by the cited references.

With respect to Burke, the Office Action has not cited to any portion of Burke regarding this claim subject matter. (See Office Action, page 2). Rather, Burke is related to the “field of digital signal processing, and in particular to the processing, storage and activation of Internet address links.” (Burke, col. 1, lines 5-7). Burke does not teach or suggest “determining... in response to the creation of a print job” nor does Burke teach or suggest anything to do with print jobs. Thus, Burke does not teach or suggest “determining the network address of the peripheral device in response to the creation of a print job that is to be sent to the peripheral device.”

The Office Action relies on Kemp to allegedly teach determining the network address “in response to the creation of the print job.” (Office Action, page 3). However, Kemp teaches that “when a new printer is installed on the network, the network administrator generally adds the printer to a listing of printers maintained on a web-server.” (Kemp, col. 6, lines 41-43). Kemp thus

describes a “network administrator” adding the printer to a “listing of printers maintained on a web-server.” (Kemp, col. 1, lines 10-24). Prior to the “network administrator” adding the printer to the “listing of printers maintained on a web-server,” the “printer configuration information and print driver information of the printer” are not located on the “website listing of printers.” (Id.) In Kemp, the workstation downloads the “printer configuration information and print driver information” when selected by a user. (Id.) However, the workstation of Kemp cannot download the “printer configuration information and print driver information” prior to the network administrator adding “the printer to a listing of printers maintained on a web-server” because the information has not yet been added to the web-server. (Id.)

The Office Action’s citation to col. 4, lines 24-39 of Kemp does not teach the “downloading of the printer information by the client from the website occurs after a printer job is submitted.” (Office Action, page 2). This section of Kemp indicates as follows:

That is, a user, wanting to print a hardcopy printout on one of printers **40 to 42** performs a process within an application program to submit the print job to a selected printer. In this regard, *before the user is able to submit the print job to one of printers 40 to 42*, necessary print driver and configuration files are required to be installed on workstation **20** in order for workstation **20** to communicate with the selected printer.

Kemp, col. 4, lines 24-32 (emphasis added). Kemp indicates that before the user is able to submit the print job, necessary print driver and configuration files are required. Such configuration files would unquestionably include the address of the printer. (Otherwise, if the address of the printer is not known, there is no way that the application could “send” the document to the printer.) The fact that Kemp indicates that the driver information and the configuration information must be known before the user can submit the print document is different than that which required by claim 1. Rather, claim 1 indicates that “determining the network address of the peripheral device in response [e.g., after] to the creation of a print job that is to be sent to the peripheral device.” Accordingly, Kemp’s teachings do not satisfy the present submit matter of claim 1.

In view of the foregoing, Applicant respectfully submits that claim 1 is patentably distinct from the cited references. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn because Kemp, alone or in combination with Burke, does not teach or suggest all of the subject matter of claim 1.

Claims 2, 3, 25-27, 31 and 32 depend either directly or indirectly from claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 2, 3, 25-27, 31 and 32 be withdrawn.

Claim 9 has been amended to recite “determining by the client device if a network address is the network address of the peripheral device, wherein determining includes sending a communication over the network.” Claim 9 further recites “creat[ing] a print job, wherein the print job is to be sent to the peripheral device” and “determin[ing] a network address of the peripheral device by the client device in response to the creation of the print job.” As discussed above, Kemp, alone or in combination with Burke, does not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that claim 9 is allowable. Claims 10 and 11 depend either directly or indirectly from claim 9, and are therefore allowable for at least the same reasons.

Claim 17 has been amended to recite “determining by the client device if a network address is the network address of the peripheral device, wherein determining includes sending a communication over the network.” Claim 17 further recites “means for creating a print job, wherein the print job is to be sent to the peripheral device” and “means for determining a network address of the peripheral device by the client device in response to the creation of the print job.” As discussed above, Kemp, alone or in combination with Burke, does not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that claim 17 is allowable. Claims 18 and 19 depend either directly or indirectly from claim 17, and are therefore allowable for at least the same reasons.

II. Claims 4-8, 12-16, 18-24 and 28-30 Rejected Under 35 U.S.C. § 103(a)

Claims 4-8, 12-16, 18-24 and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kemp in view of Burke in further view of U.S. Patent Application Publication

No. 2002/0059489 to Davis et al. (hereinafter, "Davis"). Applicant requests reconsideration in view of the above claim amendments and the following remarks.

The standard to establish a *prima facie* case of obviousness is provided above.

Claims 4-8 and 28-30 depend either directly or indirectly from claim 1. Claims 12-16 depend either directly or indirectly from claim 9. Claims 18-24 depend either directly or indirectly from claim 17. Accordingly, Applicant respectfully requests that the rejection of claims 4-8, 12-16, 18-24 and 28-30 be withdrawn for the reasons above.

III. Claim 33 Rejected Under 35 U.S.C. § 103(a)

Claim 33 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kemp in view of Burke in further view of U.S. Patent No. 7,168,003 to Lozano et al. (hereinafter, "Lozano"). Applicant requests reconsideration in view of the above claim amendments and the following remarks.

The standard to establish a *prima facie* case of obviousness is provided above.

Claim 33 depends directly from claim 1. Accordingly, Applicant respectfully requests that the rejection of claim 33 be withdrawn for the reasons above.

IV. Claim 34 Rejected Under 35 U.S.C. § 103(a)

Claim 34 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kemp in view of Burke in further view of U.S. Patent Application Publication No. 2003/0055874 to Simpson et al. (hereinafter, "Simpson"). Applicant requests reconsideration in view of the above claim amendments and the following remarks.

The standard to establish a *prima facie* case of obviousness is provided above.

Claim 34 depends directly from claim 1. Accordingly, Applicant respectfully requests that the rejection of claim 34 be withdrawn for the reasons above.

V. New Claim

New claim 35 has been added. This claim contains subject matter that is similar to claim 1. Accordingly, Applicant respectfully requests favorable consideration and allowance of this claim for the reasons set forth above.

VI. Conclusion

Applicant respectfully asserts that all pending claims are patentably distinct from the cited references, and requests that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

/Wesley L. Austin/

Wesley L. Austin
Reg. No. 42,273
Attorney for Applicant

Date: February 24, 2010

AUSTIN RAPP & HARDMAN
170 South Main Street, Suite 735
Salt Lake City, Utah 84101
Telephone: (801) 537-1700